



RECEIVED

DEC 05 2003

TECHNOLOGY CENTER R3700

AF/3729

#25 / Corrected
PATENT
Brief

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Yuji YAGI et al. ✓

Serial No.: 09/754,133 ✓

Filed: January 5, 2001

Group Art Unit: 3729

Examiner: Rick Kiltae Chang

For: CIRCUIT BOARD AND SEMICONDUCTOR DEVICE, AND METHOD OF
MANUFACTURING THE SAME

REPLY TO NOTICE OF NON-COMPLIANCE WITH 37 CFR 1.192(c)

Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants respond to the paper filed November 14, 2003 as follows.

It was stated that the Brief did not contain items required under 37 CFR 1.192(c) or that the items were not under the proper heading or in the proper order.

Enclosed is a copy of the Table of Contents for the Brief and a highlighted copy of the most recent version of 37 CFR 1.192. A review of the former will show that the headings for each of the

Serial No. 09/754,133

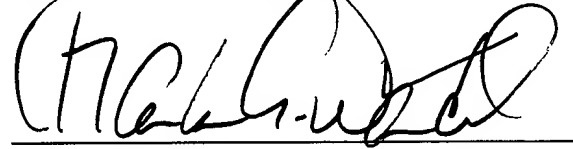
first eight sections corresponds exactly to the headings in the rules. Clarification therefore is requested.

It was stated that the Brief did not contain a correct copy of the appealed claims as an Appendix thereto. It is believed that such a copy was filed but applicants enclose herewith three copies of that appendix.

The Examiner is requested to telephone the undersigned if anything further is required.

Respectfully submitted,

PARKHURST & WENDEL, L.L.P.



Charles A. Wendel

Registration No. 24,453

December 3, 2003

Date

CAW/ch

Enclosures

Attorney Docket No.: MEIC:053A

PARKHURST & WENDEL, L.L.P.
1421 Prince Street, Suite 210
Alexandria, Virginia 22314-2805
Telephone: (703) 739-0220

PLEASE ACCEPT THIS AS
AUTHORIZATION TO DEBIT
OR CREDIT FEES TO
DEP. ACCT. 16-0331
PARKHURST & WENDEL



RECEIVED

DEC 05 2003

TECHNOLOGY CENTER R3700

TABLE OF CONTENTS

	<u>Page</u>
I. REAL PARTY IN INTEREST	1
II. RELATED APPEALS AND INTERFERENCES	1
III. STATUS OF CLAIMS	1
IV. STATUS OF AMENDMENTS	2
V. SUMMARY OF INVENTION	2
VI. ISSUES	3
VII. GROUPING OF CLAIMS	4
VIII. ARGUMENT	4
1. Summary of Argument	4
2. Abe '868	5
3. Official Notice	8
4. Murakami '780	8
5. The Purported Justification for the Rejection	9
IX. CONCLUSION	10

Appeals and Interferences by filing a notice of appeal and the fee set forth in § 1.17(b) within the time period provided under §§ 1.134 and 1.136 for reply. Notwithstanding the above, for an *ex parte* reexamination proceeding filed under § 1.510 for a patent that issued from an original application filed in the United States on or after November 29, 1999, no appeal may be filed until the claims have been finally rejected (§ 1.113). Appeals to the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings filed under § 1.913 are controlled by §§ 1.959 through 1.981. Sections 1.191 through 1.198 are not applicable to appeals in *inter partes* reexamination proceedings filed under § 1.913.

(b) The signature requirement of § 1.33 does not apply to a notice of appeal filed under this section.

(c) An appeal when taken must be taken from the rejection of all claims under rejection which the applicant or patent owner proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

(d) The time periods set forth in §§ 1.191 and 1.192 are subject to the provisions of § 1.136 for patent applications and § 1.550(c) for reexamination proceedings. The time periods set forth in §§ 1.193, 1.194, 1.196 and 1.197 are subject to the provisions of § 1.136(b) for patent applications or § 1.550(c) for reexamination proceedings. See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

(e) Jurisdiction over the application or patent under reexamination passes to the Board of Patent Appeals and Interferences upon transmittal of the file, including all briefs and examiner's answers, to the Board. Prior to the entry of a decision on the appeal, the Director may sua sponte order the application remanded to the examiner.

(35 U.S.C. 6, Pub. L. 97-247; 15 U.S.C. 1113, 1123)

[46 FR 29183, May 29, 1981, as amended at 49 FR 555, Jan. 4, 1984; 49 FR 48453, Dec. 12, 1984; 54 FR 29552, July 13, 1989; 58 FR 54510, Oct. 22, 1993; 62 FR 53196, Oct. 10, 1997; 65 FR 76774, Dec. 7, 2000]

§ 1.192 Appellant's brief.

(a) Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate. The brief must be accompanied by the fee set forth in § 1.17(c) and must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

(b) On failure to file the brief, accompanied by the requisite fee, within the time allowed, the appeal shall stand dismissed.

(c) The brief shall contain the following items under appropriate headings and in the order indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner:

(1) *Real party in interest.* A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest.

(2) *Related appeals and interferences.* A Statement identifying by number and filing date all other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) *Status of claims.* A statement of the status of all the claims, pending or cancelled, and identifying the claims appealed.

(4) *Status of amendments.* A statement of the status of any amendment filed subsequent to final rejection.

(5) *Summary of invention.* A concise explanation of the invention defined in the claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.

(6) *Issues.* A concise statement of the issues presented for review.

(7) *Grouping of claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group

§1.193

and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

(8) *Argument.* The contentions of appellant with respect to each of the issues presented for review in paragraph (c)(6) of this section, and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate heading.

(i) For each rejection under 35 U.S.C. 112, first paragraph, the argument shall specify the errors in the rejection and how the first paragraph of 35 U.S.C. 112 is complied with, including, as appropriate, how the specification and drawings, if any,

(A) Describe the subject matter defined by each of the rejected claims.

(B) Enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims, and

(C) Set forth the best mode contemplated by the inventor of carrying out his or her invention.

(ii) For each rejection under 35 U.S.C. 112, second paragraph, the argument shall specify the errors in the rejection and how the claims particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(iii) For each rejection under 35 U.S.C. 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

(iv) For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject

matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

(v) For any rejection other than those referred to in paragraphs (c)(8) (i) to (iv) of this section, the argument shall specify the errors in the rejection and the specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error.

(9) *Appendix.* An appendix containing a copy of the claims involved in the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and provided with a period of one month within which to file an amended brief. If appellant does not file an amended brief during the one month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

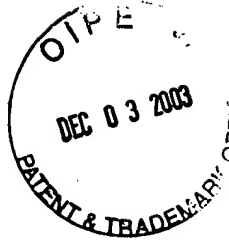
(35 U.S.C. 6, Pub. L. 97-247; 15 U.S.C. 1123)

[36 FR 5850, Mar. 30, 1971, as amended at 36 FR 23734, June 23, 1988; 58 FR 54510, Oct. 1993; 60 FR 14518, Mar. 17, 1995; 62 FR 5000, Oct. 10, 1997]

§1.193 Examiner's answer and reply brief.

(a)(1) The primary examiner within such time as may be directed by the Director, furnish a written answer in answer to appellant's brief including such explanation of the invention claimed and of the references grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner finds that an appeal is not regular in form or not relate to an appealable action, the primary examiner shall so state.

(2) An include : if an am to add c and app amendm tered for individua action f taken w or amen brief mu the claim amendme was so a swer ma the claim amendme was so ad ment und purposes lant's co any appe added or under \$1 set forth appeal wa (b)(1) A to, an ex mental e months f iner's an iner's an sions of t a patent extension brief in The prim knowle reply bri tion and to the re amine's less the e by the I Interfer (4) Whe the prim or reply must ex options applicati (4) File Dec 2006 (4) Reg part of a



CLAIMS ON APPEAL

RECEIVED

DEC 05 2003

TECHNOLOGY CENTER R3700

24. A method of manufacturing a circuit board comprising a plurality of wiring patterns each extending across a surface of an insulating substrate for connecting at least two locations on the substrate, and a plurality of protrusions located at desired locations on the wiring patterns, the method comprising:

simultaneously and unitarily forming the wiring patterns and the protrusions.

25. The method of manufacturing a circuit board as defined in Claim 24, wherein the wiring patterns and the protrusions are made of a same conductive sintered material.

29. A method of manufacturing a semiconductor device comprising the steps of:

simultaneously and unitarily forming a first plurality of wiring patterns and a second plurality of protrusions located at desired locations on the wiring patterns on an insulating substrate, the protrusions having substantially equal heights, the wiring patterns each extending across a surface of the substrate for connecting at least two locations on the substrate; and

coupling electrically the protrusions and electrodes disposed on a semiconductor chip component.

30. The method of manufacturing a semiconductor device as defined in Claim 29, wherein the wiring patterns and the protrusions are made of a same conductive sintered material.

35. The method of manufacturing a circuit board as defined in claim 24, further comprising modifying the protrusions to have substantially equal heights.

36. The method of manufacturing a circuit board as defined in claim 35, wherein said modifying comprises imposing a load on said protrusions.